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10/020,853	12/11/2001	Gholam-Reza Zadno-Azizi	VGEN.001A	6673

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 12/03/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,853

Applicant(s)

ZADNO-AZIZI ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 22-69 is/are pending in the application.
- 4a) Of the above claim(s) 27-30, 44 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 22-26, 31-43, and 46-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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The following is a modified version of the final Office action mailed on November 18, 2003, and is in response to the supplemental Amendment received on October 31, 2003, but entered into the file after said mailing.

Claims 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 40, the last two lines contradict the newly added limitations of claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 11-17, 22, 24, 26, 43, 62, 68, and 69 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hara et al., *Ophthalmic Surgery*, February 1990, Vol. 21, No. 2, pp. 128-133. In a preferred embodiment, the anterior optic has a refractive power of +20 diopters and the posterior optic has a refractive power of 0 diopters for a combined power of +20 diopters (page 130, second column). A force of 720 mgf is required to shorten the distance

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between the optics by 1.0 mm (page 131, lines 7-8); therefore, the optics are biased toward an ~~un~~accommodated position, as further evidenced by the sentence on page 130, second column, lines 26-28. Accommodation imparts a 2 diopter change in optical power (page 131, first line). Regarding claims 22, 24, and 26: Figure 1. Regarding claim 43, the optics are removable in the sense that the entire implant is removable. ✓

Claims 31-33, 46-60, and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al., *Ophthalmic Surgery*, February 1990, Vol. 21, No. 2, pp. 128-133. Regarding claims 31-33, the particular values for the radii of curvature would have been obvious to the one of ordinary skill in order to provide a range of diopter values to accommodate a variety of patients, particularly since "the lens power may be distributed differently between the two optics" (page 131, first column, lines 22-25). Regarding claims 46-60 and 63-66, official notice is taken that the particular coatings and surface treatments were well known in the art and would have been obvious to the ordinary practitioner, who would have been motivated by the known advantages of said coatings and treatments and by the intent of Hara et al. to place the posterior lens against the capsular bag so as to act as a footplate (page 131, lines 12-18) and to maintain the integrity of the capsular bag (page 131, lines 27-29).

Claims 40-42, 61, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al., *Ophthalmic Surgery*, February 1990, Vol. 21, No. 2, pp. 128-133, in view of Hara et al., JP 2-126847 A. Regarding claims 40-42, providing separate biasers would have been obvious from Figures 4-8 of the Japanese patent document and from the suggestion in the journal article that the strength of the spring loops may be changed (page 131, first column, lines 22-25) and from the inherent need to provide an optimum haptic material for capsular bag contact and

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an optimum material for appropriate spring characteristics, with motivation to combine the teachings having been provided by the fact that both references appear to disclose the same embodiment, with variations being described in the Japanese patent document. Regarding claim 61, a posteriorly-extending perimeter wall would have been obvious from Figures 9-10 of the Japanese patent in view of the advantage cited at the top of page 16 of the English translation. The further limitations of claim 67 would have been obvious from Figures 4, 5, and 8 of the Japanese patent document.

Claims 1-17, 22-26, 31-39, 43, 46-60, and 62-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarfarazi, US 6,488,708, which discloses an anterior optic **42** and a posterior optic **44**, the two optics being biased apart from each other toward an accommodated position (column 5, lines 1-12). Sarfarazi lacks specifics as to refractive powers, but since "dual lens designs find use in providing full accommodative restoration of vision to presbyopic patients" (column 10, lines 24-25), a combined power within the range of 15 to 25 diopters would have been immediately obvious to the ordinary practitioner in view of the typical requirements for the population of presbyopic patients. The anterior optic **42** having a refractive power less than 30 diopters and the posterior optic **44** having a refractive power of between -10 and -5 diopters would have been obvious from the aforementioned combined power range; from column 8, lines 53-58; and from the materials listed at column 7, lines 41-45. The ranges presented in instant claims 15-17 would have been obvious from Figure 10 and column 8, lines 53-58. Regarding claims 23-26, Figure 10 shows anterior and posterior surfaces which are substantially flat when in the unaccommodated position and which are generally convex when in the accommodated position (phantom lines). Regarding claims 31-39, the particular values

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pertaining to refractive powers (and radii of curvature) would have been obvious from the diversity of materials (column 7, lines 41-45), presbyopic patients, and lens types (column 3, line 60, to column 4, line 5; column 7, lines 24-41) and from the impetus to optimize the accommodation function (column 8, lines 53-61). Regarding claims 46-60 and 63-66, official notice is taken that the particular coatings and surface treatments were well known in the art and would have been obvious to the ordinary practitioner, who would have been motivated by the known advantages of said coatings and treatments and by the intent of Sarfarazi to implant the device into a capsular bag of an eye.

The Applicant's remarks have been reviewed but are deemed to be moot in view of the new grounds of rejection, which were necessitated by the added claim language pertaining to the optics being biased toward the accommodated position.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

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A handwritten signature in black ink, appearing to read 'Dave Willse', with a long horizontal flourish extending to the right.

Dave Willse
Primary Examiner
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